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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,701	10/12/2001	Michael C. Dorsey	P6954	2152

7590 01/04/2005

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EXAMINER

TRIMMINGS, JOHN P

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/976,701	DORSEY, MICHAEL C.	
	Examiner	Art Unit	
	John P Trimmings	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004 and 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/28/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to the applicant's amendment dated 8/16/2004.

Claims 1-8, 12, 13, 15-20, 23, 24, 26, 32 and 33 have been amended.

Claims 1-39 are pending.

Information Disclosure Statement

The examiner has considered the applicant's Information Disclosure Statement of 7/26/2004.

Response to Amendment

1. Objections to Drawings:

In view of the amendments to FIG.s 1, 2 and 9, the examiner withdraws objections to said figures and approves the replacement sheets.

2. Objections to Specifications:

In view of the changes to the specification, the examiner withdraws objections to said specification and approves the replacement sheets.

3. Objections to Claims:

In view of the changes to Claims 1, 8, 15, 16 and 23, the examiner withdraws objections to said claims.

4. Double Patenting:

The examiner acknowledges receipt of applicant's Terminal Disclaimer.

5. 35 USC 112 First Paragraph Rejections:

As per Claims 2, 10, 16, 28 and 32:

Although the applicant has defined "paranoid check" in the amendment, the disclosure still lacks further defining how a paranoid check is stored in the MBIST signature register. And it is still unclear to the examiner if there are bits generated to identify the "results" of such a check, or whether the memory cell testing generates a certain signature "result". Therefore, the examiner is still unsure of what the term means, and so the rejections under 35 USC First Paragraph are maintained.

6. 35 USC 112 Second Paragraph Rejections:

As per Claims 2, 10, 16, 28 and 32:

Although the applicant has defined "paranoid check" in the amendment, the disclosure still lacks further defining how a paranoid check is stored in the MBIST signature register. And it is still unclear to the examiner if there are bits generated to identify the "results" of such a check, or whether the memory cell testing generates a certain signature "result". Therefore, the examiner is still unsure of what the term means, and so the rejections under 35 USC Second Paragraph are maintained.

As per Claims 5, 7, 19 and 32:

In view of the applicant's amendments, re: proper antecedent basis, the examiner's rejections are withdrawn.

Response to Arguments

7. Section 102 and 103 Rejections:

As per Claims 1, 9, 15, 24 and 33:

Applicant's arguments filed 8/16/2004 have been fully considered but they are not persuasive. The applicant has relied upon new amendments to the said claims, except Claim 9, which new amendments are rejected under 35 USC 112 First Paragraph (see new rejections below). Therefore, the examiner maintains the original rejections to independent Claims 1, 9, 15, 24 and 33 as presented in the first office action of 5/12/2004. And in view of the applicant's reliance on the said amendment to Claims 1, 9, 15, 24 and 33 only, the dependent Claims 2-8, 10-14, 16-23, 25-32 and 34-39 are also rejected as per the first office action. In total, all claims 1-39 are maintained as being rejected.

New Claim Rejections - 35 USC § 112

8. Claims 1, 15, 24 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter, which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In regard to this matter, the applicant has limited the "signature" in these claims to comprise MBIST "engine states". The applicant's figure 8 identifies five MBIST engine states (810-850). But there is no discussion within the Specification as to how these five engine states are stored in the signature register. The examiner is also unsure as to how a "state" is stored in a register, and since this is not described, the claims lack support from the disclosure.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P Trimmings whose telephone number is 703-305-0714. The examiner can normally be reached on Monday through Thursday, 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on 703-305-9595. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2133

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P Trimmings
Examiner
Art Unit 2133

jpt



Guy J. LAMARRE
PRIMARY EXAMINER